



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Re Application Of:

DAVID D. BOYD, and MICHAEL W. JOHNSON

Date: September 5, 2003

Serial No. : 09/972,790

Our File: BYD 327

Filing Date : October 5, 2001

Group Art Unit: 1761

For : ENCODED COFFEE PACKET

Examiner: Weinstein, S.

MAIL STOP: FEE RESPONSES

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

**RESPONSE TO RESTRICTION REQUIREMENT**

Responsive to the restriction requirement dated July 8, 2003, applicants elect Group I, including claims 1-14 and 22-25, drawn to a brewing packet.

As required by the restriction requirement, applicants elect, with traverse, species A, wherein the machine interpretable feature is electromagnetically detectable. Restriction is only proper when a search and examination of an entire application places a serious burden on the examiner. MPEP § 803. Applicants respectfully submit that the Examiner has not established a *prima facie* case that a search and examination of both species A and B presents the Examiner with a serious burden. Applicants respectfully assert that claims 1, 2, 3, 4, 5, 6, 22, 23, 24 and 25 are generic with respect to species A.

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As further required by the restriction requirement, applicants elect, with traverse, subspecies A5, where the interpretable feature is a barcode. Again, applicants respectfully submit that the Examiner has not established a *prima facie* case that a search and examination of all subspecies A1-A6 presents the Examiner with a serious burden. Moreover, in order for claims to be restricted, the species must be mutually exclusive. The general test as to when claims are restricted, respectively, to different species, is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not for the first i.e. the claims must recite mutually exclusive characteristics of each species (MPEP § 806.04(f).) However, the species indicated by the Examiner are not indicated by the disclosure as being mutually exclusive. Specifically, page 7, lines 20-22 state, “the above-noted machine interpretable features; or other machine interpretable features, may similarly may be employed *in combination* or alone...” (emphasis added). Applicants respectfully assert that claims 1, 2, 3, 4, 5, 6, 11, 12, 13, 14, 22, 23, 24, and 25 are generic with respect to subspecies A5.

As required by the restriction requirement, applicants elect, with traverse, Species C, wherein the encoded data includes a predefined brewing directive. Applicants respectfully submit that the Examiner has not established a *prima facie* case that a search and examination of both Species C and D presents the Examiner with a serious burden.

Moreover, the species indicated by the Examiner are not indicated by the disclosure as being mutually exclusive. Specifically, page 7, line 22 - page 8, line 24 state, "...such features being selected for their ability to store brewing directives and packet *and/or* ingredient - characteristic data..." (emphasis added). Applicants respectfully assert that claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 22, 23, 24, and 25 are generic with respect to Species C.

As further required by the restriction requirement, applicants elect Subspecies C1, where the directive is contact time, with traverse. Again, applicants respectfully submit that the Examiner has not established a *prima facia* case that a search and examination of all subspecies C1-C6 presents the Examiner with a serious burden. Moreover, the species indicated by the Examiner are not indicated by the disclosure as being mutually exclusive. Specifically, page 8, lines 7-10 state, “Examples of the types of brewing directives stored in machine interpretable feature 30 may include, for example, contact time, contact pattern, fluid volume, fluid temperature, fluid pressure, *and/or* fluid pass-through rate.” Furthermore, claim 12, as originally filed, recites “...wherein the predefined brewing directive is *one or more of* contact time, contact pattern, fluid quantity, fluid temperature, fluid pressure, or fluid pass-through rate.” Applicants respectfully assert that claims 1, 2, 3, 4, 5, 6, 7, 8, 9, 10, 11, 12, 22, 23, 24, and 25 are generic with respect to subspecies C1.

Thus, for the above reasons, applicants respectfully submit that restriction of the present case with respect to the various species and subspecies is improper. However, should the Examiner maintain the restriction requirement between these species and subspecies, this

will be interpreted as an assertion that that claims directed to the different species and subspecies are patentably distinct and thus a reference disclosing one species or subspecies cannot be used to anticipate or obviate another species or subspecies.

Respectfully submitted,

KOLISCH HARTWELL, P.C.

  
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: MAIL STOP: FEE RESPONSES, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on September 5, 2003.

  
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